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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,586	04/08/2004	Boris Mayer	30691/DP008	8111
4743	7590	09/20/2005	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			BANGACHON, WILLIAM L	
			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/820,586

Applicant(s)

MAYER ET AL.

Examiner

William Bangachon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/8/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date, \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Examiner's Response***

1. In response to the application filed 4/8/2004, the application has been examined. The Examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. It is the Examiner's position that claims 1-11 are unpatentable for the reasons set forth in this Office action:

### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. In this case, the abstract recites "Disclosed herein..."

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no description of a user input device, processor, and controller recited in claim 11.

### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the **"means for acquiring information from users"**, **"means for assigning the users to user**

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**groups”, “system control”, and several functions of the electronic parcel compartment system**, recited in claim 1; data line recited in claims 2 and 4; **“database”** recited in claim 5; **“user input device, processor, and controller”**, recited in claim 11, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

5. Claims 1, 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the **“means for acquiring information from users”** lacks the necessary structural cooperative relationship with the rest of the elements in the claim (i.e. no structural relationship with the “means for assigning the users to user groups” and the “system control”). It is unclear and ambiguous on how the different elements in the claim interact to form an electronic parcel compartment system.

Claim 7 recites the limitation **“certain parcel compartments and groups of parcel compartments,”** claim 8 recites the limitation **“parcel compartment”** in page 16. There is insufficient antecedent basis for these limitations in the claim.

In claim 11, the **“user interface, processor, and controller”** lacks structural cooperative relationship. There is no indication in the claim on how these elements are structurally related. It is unclear on whether these elements belong to different apparatuses and forming a system to allow a user belonging to a group have access to several functions of the system.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,774,053 {Porter} in view of USP 6,456,900 {Kakuta}.

In claim 1, Porter teach of a electronic storage device (10) (the electronic parcel compartment system) with a user interface (26, 30) {col. 3, lines 42+}, for the delivery and pickup of goods, the user interface comprising a keypad (26) (the means for acquiring information from users of the electronic parcel compartment system) {col. 6, lines 6-15}, the electronic storage device comprises means for assigning vendors and/or homeowners (the users) to vendor groups (46) {col. 5, lines 37+} and being provided with a system control that allows a user to have access to a selection of several functions (such as locking, unlocking, notify customers, turn on AC or heating) of the electronic parcel compartment system, depending on the user group (vendors, homeowners, apartment dwellers) to which the user belongs {col. 5, lines 53-64; col. 6, lines 30-55}.

Porter does not disclose expressly a compartment system. However, these claim limitations would have been obvious in the system of Porter, as evidenced by Kakuta. Kakuta, in the same field of endeavor (unattended merchandise delivery system), teach of a conventional locker (compartment) type delivery system installed in public places and apartment housing {Kakuta, col. 2, lines 1+; col. 2, lines 51+; col. 3, lines 23+; Figures 1-7} for the purpose of delivering merchandise to customers through non-store retail services such as the internet {Kakuta, col. 1, lines 7-21}. Obviously, locker or compartment type storage devices for delivering merchandise, as taught by Kakuta, is beneficial in the system of Porter, to one of ordinary skill in the art, because merchandise can be delivered to multiple homes individually that provides security and privacy to customers.

In claims 2 and 4, the means for assigning the users (vendors, homeowners) to user groups (46) makes this assignment on the basis of information transmitted via a data line as shown in Figure 5 {Porter, col. 6, lines 6-7}.

In claim 3, the means for assigning users to user groups (46) is connected to the user interface (26, 30) in such a way that the information acquired from the user interface is available to said means for the assignment of the users {Porter, col. 5, lines 37+}.

In claim 5, the assignment to the user groups is performed by acquiring user identification information and by making a comparison of the user identification information to an entry in a database {Porter, col. 6, lines 6-15, lines 30-51}.

In claim 6, wherein different access authorizations to functions of the electronic parcel compartment system can be selected for different user groups {Porter, col. 6, lines 42+}.

In claim 7, at least one of certain parcel compartments and groups of parcel compartments are accessible only to certain user groups {Porter, col. 8, lines 12-22}.

In claim 8, the assignment of the parcel compartments to the user groups can be changed {Porter, col. 7, lines 46-50}.

Claims 9 and 10 recites the system of claim 1 and 7 and therefore rejected for the same reasons.

Claim 11 recites the combination of claims 1 and 7 and therefore rejected for the same reasons.

#### ***Office Contact Information***

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to William Bangachon whose telephone number is **(571)-272-3065**. The Examiner can normally be reached on 4/4/10.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Michael Horabik can be reached on **(571)-272-3068**. The fax phone numbers for the organization where this application or proceeding is assigned is **571-273-8300** for regular and After Final formal communications. The Examiner's fax number is **(571)-273-3065** for informal communications.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



William L. Bangachon  
Examiner  
Art Unit 2635

September 18, 2005

MICHAEL HORABIK  
SUPERVISORY PATENT EXAMINER  
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